

MERCK KGAA,	)	IPC NO. 14-2002-00049
Opposer,	)	Opposition to:
	)	Application Serial No. 117755
	)	Filed: 10 February 1997
	)	Trademark: "COR"
-versus-	)	For: Pharmaceutical preparations
	)	in the cardiovascular field
	)	
COR THERAPEUTICS, INC.	)	
Respondent-Applicant.	)	
	)	Decision No. 2003-26
x-----x	)	

D E C I S I O N

This pertains to the Notice of Opposition filed by MERCK KGAA., a corporation organized and existing under the laws of Germany, with address at Frankfurter Strasse 250, D-64293, Darmstadt, Germany, against the registration of the trademark "COR" for goods under Class 5 with Application Serial No. 117755 and filed on 10 February 1997 in the name of COR THERAPEUTICS INC., a corporation organized and existing under the laws of the state of Delaware, USA, with address at 256 East Grand Avenue, South San Francisco, California 94080, USA.

Opposer filed the instant Notice of Opposition with the Intellectual Property Office on 20 September 2002, based on the following grounds:

“1. Opposer is the owner of the trademark CONCORE used on ‘beta adrenergic blocking agent’ classified under Class 5.

2. Said trademark has been used by the opposer in trade and commerce for the aforementioned goods under Class 5, which products have been and now are widely offered for sale and marketed and sold in the Philippines since April 1991.

3. In the Philippines, opposer has in its favor a Trademark Registration No. 56942 dated February 4, 1994, issued by the then Bureau of Patents, Trademarks and Technology Transfer (BPTTT), now Intellectual Property Office (IPO). Said registration was issued in respect of class 5 products (beta adrenergic blocking agent) and is still valid, subsisting and not cancelled.

4. The trademark CONCORE has acquired goodwill and distinctiveness especially in respect of class 5 products.

5. x x x

6. The respondent-applicant is not now and never was entitled to appropriate or register the trademark COR, for ‘pharmaceutical preparations in the cardiovascular field’, classified under Class 5.

7. The respondent-applicant was not was entitled to the exclusive use a (sic) trademark COR, for which it seeks registration in its Application Serial No. 117755, either on February 10, 1997, the date of the filing of the application for registration thereof, or on May 22, 2002, the date of the publication thereof in the Official Gazette.

8. Since April 1991, opposer has been and is now using in trade and commerce in the Philippines the mark CONCORE in respect of Class 5 products.

9. Respondent-Applicant's mark COR so resembles Opposer's trademark CONCORE as to be likely, when applied to the products of the respondent-applicant, to cause confusion or to cause mistake, or to deceive. The respondent-applicant's products and those of the Opposer's are similar, identical and/or are related and therefore belong to the same class or kind such that the use of the mark COR will cause confusion or mistake or deceive purchasers as to the source of origin of said goods to such extent as may be mistaken by the unwary public as products originating from the opposer.

10. The opposer and respondent-applicant's goods are used by the same people and are traded and sold through the same channels of trade and in the same manner, which increases the likelihood of confusion, mistake or deception.

11. The registration of the respondent-applicant's mark would therefore violate Section 123.1(d) of the Intellectual Property Code (R.A. 8293) and Rule 101(d) of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers."

The Notice to Answer, dated 24 September 2002, was sent to the Respondent-Registrant's counsel on 01 October 2002. On 11 October 2002, Respondent-Registrant filed its Answer, specifically denying all the averments in the Notice of Opposition and raising the following special and affirmative defenses:

"x x x

7. Respondent-Applicant's mark, 'COR' is an internationally-known mark registered and applied for registration in various countries including countries which adhere to the Paris Convention.

8. Respondent-Applicant's right to register the mark 'COR' in the Philippines is guaranteed by the Paris Convention.

9. Respondent-Applicant's mark, 'COR' is entirely different from Opposer's mark 'CONCORE' not only in appearance and spelling but also in sound as well as in length.

10. While Opposer highlights in paragraphs 9 and 10 of the Notice of Opposition that both such marks cover the same class of products and are used by the same group of purchasers, the Opposer was noticeably silent as to the precise nature of the products covered by the marks – pharmaceutical products in the cardiovascular fields – aware, most likely that likely hood (sic) of confusion is remote with respect to such pharmaceutical products. No less than the Supreme Court has ruled that:

"In the solution of a trademark infringement problem, regard too should be given to the class of persons who buy the particular product and the circumstances ordinarily attendant to its acquisition. The medicinal preparations, clothed with the trademarks in question, are unlike articles of everyday use such as candies, ice cream, milk, soft drinks and the like which may be freely obtained by anyone, anytime, anywhere. Petitioner's and respondent's products are to be dispensed upon medical prescription. The respective labels say so. An intending buyer must have to go first to a licensed doctor of

medicine: he receives instructions as to what to purchase: he reads the doctor's prescription; he knows what he is to buy. He is not of the incautious, unwary, unobservant or unsuspecting type; he examines the product sold to him; he checks to find out whether it conforms to the medical prescription. The common trade channel is the pharmacy or the drugstore. Similarly, the pharmacist or druggist verifies the medicine sold. The margin of error in the acquisition one for the other is quite remote.

We concede the possibility that buyers might be able to obtain Pertussin or Atussin without prescription. When this happens, then the buyer must be one thoroughly familiar with what he intends to get, else he would not have the temerity to ask for a medicine – specifically needed to cure a given ailment. In which case, the more improbable it will be to pal off one for the other. For a person who purchases with open eyes is hardly the man to be deceived.” (*Etepha, A.G., vs. Director of Patents and Westmont Pharmaceuticals, Inc., 16 SCRA 495, 501-502*)

In the cited *Etepha A.G. Case*, the products involves are medicine for ordinary cough and the marks involves, which the Supreme Court ruled to be not confusingly similar, are “PERTUSSIN” and “ATUSSIN”. In the instant case, the products covered by the mark are pharmaceutical products not just for ordinary common cold or cough, but for the treatment of cardiovascular disease. As a matter of fact, the labels submitted by the Opposer clearly indicates the warning: ‘Foods, Drugs, Devices and Cosmetics Act prohibits dispensing without prescription,’”

The issues having been joined, the case was set for Pre-Trial Conference on 13 November 2002. In its Pre-Trial Brief, the Opposer added the following issue in opposing the registration o the trademark COR in the name of the Respondent-Applicant:

“2. Whether or not the mark COR which means HEART, is descriptive of the goods (pharmaceutical preparations in the cardiovascular field), and therefore not registrable under existing trademark laws and regulations.”

For its part, Respondent-Applicant suggested in its Pre-Trial Brief that the instant case be resolved on the sole issue of whether the subject marks are confusingly similar to each other. According to respondent-Applicant: “Since there is no dispute as to the material facts (i.e. the appearance, spelling and pronunciation of the marks as well as the goods covered by them) upon which the sole issue in this case can be resolve (sic), the instant case can be submitted for resolution even without pretrial conference and, much less, formal trial or presentation of evidence.” With this submission, Respondent-Applicant did not appear during the scheduled hearing on 13 November 2002 and thus was declared in default as per Order No. 2002-537, which was issued by this Office on 14 November 2002 and received by Respondent on 21 November 2002. Opposer was then allowed to present its evidence ex-parte.

Admitted as evidence for the Opposer are Exhibits “A” to “G” inclusive of sub-markings, consisting of Certificate of Trademark Registration No. 56942 for the mark CONCOR, issued in the name of Merck Kgaa; various CONCOR labels and packaging material; Joint Affidavit of Ulrich Fogel and Horst Semisch, principal officers of the Opposer corporation; Affidavit of Mona Lita S. Marcha, Regulatory Affairs Manager of Merck, Inc.; and copies of a printed page and a website page of the MIMS Manual.

The issues to be resolved in this particular case are: (a) whether or not there exists a confusing similarity between the Opposer's trademark CONCORE and Respondent-Applicant's trademark COR; and (b) whether or nor the trademark COR is a descriptive mark. Respondent-

Applicant would have this Office limit the issue of the case to confusing similarity. However, the issue as to the descriptiveness of the trademark COR goes into the very essence of its registrability and, therefore, must be considered even though it is raised only in the Opposer's Pre-Trial Brief and not in the Notice of Opposition.

Considering the Certificate of Registration No. 57569 subject of the instant petition for cancellation was issued under the old Trademark Law (R.A. 166, as amended), this Office shall resolve the case under the said law so as not to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293)

The applicable provision of the Trademark Law, Sections 4(d) and 4(e) provide:

“Sec 4. *Registration of trademarks, trade-names and service-marks on the principal register* --- xxx The owner of a trademark, trade-name or service-mark used to distinguished his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:

x x x

“(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers.”

“(e) Consists of a mark or trade name which, when applied to or used in connection with the goods, business or services of the applicant is merely descriptive or deceptively misdescriptive of them, or when applied to or used in connection with the goods, business or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, or is primarily merely a surname.”

The determinative factor in a contest involving registration of trademark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of the mark would *likely* cause confusion or mistake on the part of the buying public. The law does not require that the competing trademarks must be so identical as to produce actual error or mistake. For infringement to exist, it would be sufficient that the similarity between the two trademarks is such that there is a possibility or likelihood of the older brand mistaking the newer brand for it.

In the case of case of *Etepha vs. Director of Patents (16 SCRA 502)*, the Supreme Court stated that:

“The essential element of infringement is colorable imitation. This term has been defined as “such a close or ingenious imitation as to be calculated to deceive ordinary purchasers, or such resemblance of the infringing mark to the original as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one, supposing it to be the other.”

A comparison of the trademark CONCORE and COR will show that the first is distinguishable from the second. CONCORE consists of two (2) syllables, which are spelled, written and pronounced differently from the mark COR. These differences preclude the possibility

of the purchasing public confusing one product with the other. Besides, purchasers of cardiovascular medicine are ordinarily more wary of the products they are buying, since these products affect a person's health and in the extreme may mean life or death. The source or manufacturer of the article will be a most important factor in the mind of the purchaser in selecting the article he will buy.

As to the second issue raised by the Opposer, there are several tests of descriptiveness, only one of which need be met. We ask whether the mark describes ingredients, qualities or characteristics of goods; whether it conveys information regarding a function, purpose or use of the goods; whether it describes a feature or part of the goods or imparts information about certain properties of the goods. (*In re Abcor Development Corporation*, 200 USPQ 215.

In the case *In re National Presto Industries, Inc.* (197 USPQ 188) the Trademark Trial and Appeal Board (TTAB) of the United States Patent and Trademark Office (USPTO) affirmed the decision of the trademark examiner who required the disclaimer of the word "BURGER" for merely being descriptive of electric cooking utensils, to wit:

"It is settled law that whether or not a term is merely descriptive must be decided in relation to the goods for which registration is sought and on the impact that it is likely to make in the average purchaser of goods. See: *Roselux Chemical Co., Inc. vs. Parsons Ammonia Company Inc.*, 132 USPQ 627 (CCPA 1962); *In re Marine Protein Corporation*, 183 USPQ 62 (TT&A Bd., 1974). It is equally well-established that a term is merely descriptive if it describes the purpose or function for which the goods are to be used. See: *In re The Realistic Company*, 169 USPQ 610 (CCPA, 1971); *In re G.E. Smith, Inc.*, 138 USPQ 518 (TT&A Bd., 1963). Judged in the light of these criteria, it is our judgment that the word 'BURGER' as applied to the applicant's product, will immediately inform the average potential customer that this is a utensil for making hamburgers.

x x x

"We conclude, therefore, that the word "BURGER" is merely descriptive of electrical cooking utensils because it immediately informs ordinary purchasers what function of the product is. As such, the word "BURGER" is an unregistrable component of the mark."

In the instant case, the trademark COR is used for "pharmaceutical preparations in the cardiovascular field." The trademark, which is the Latin word for HEART (Webster's Third New International Dictionary), immediately informs the buyer that the product is to be used for cardiovascular problems. Clearly, the mark COR is not merely suggestive, but descriptive of the product. A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. (*Stix Products, Inc. vs. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 160 USPQ 777). Under the imagination test, the question is how immediate and direct is the thought process from the mark to the particular characteristic of the product. (*AMF, Inc vs. Sleekcraft Boats*, 599 F.2d 341, 204 USPQ 808). Thus, if one must exercise "mature thought or follow a multi-stage reasoning process" to determine attributes of the product of service, the term is suggestive, not descriptive. (*In re Tennis in the Round, Inc.*, 199 USPQ 496 [TTAB 1978]). If the material leap between the word and the products' attributes is not almost instantaneous, this strongly indicates suggestiveness, not descriptiveness. (*Investacorp, Inc. vs. Arabian Investment Banking Corp.*, 931 F.2d 1519, 19 USPQ 2d 1056). In the instant case, however, such, "multi-stage reasoning process" is absent as the term COR, which means HEART directly and clearly conveys information as to the function of the product.

That the term COR is a Latin term not commonly recognized to mean HEART in English is not an argument for its registrability. The foreign equivalent of a merely descriptive English word is no more registrable than its English equivalent would be, regardless of whether or not the

foreign term would have any meaning to the general public. Thus, in *In re Organon Teknika Corporation* (216 USPQ 935) the Trademark Trial and Appeal Board of the USPTO ruled:

“Nephros’ is descriptive as applied to applicant’s goods defined as ‘an apparatus substituted for the kidney to filter waste products from the blood artificially’ (The Random House College Dictionary). x x x

A dialyzer is a filtering apparatus which acts in the manner of an artificial kidney. “NEPHROSS’ clearly describes the apparatus simply because it is the foreign equivalent of the word kidney, albeit a minor variation in spelling, Applicant’s misconception of the law on this point is noted in the statement that “(w)e believe the word ‘NEPHROSS’ is not commonly recognized by even the most sophisticated of potential purchasers ‘as meaning’ anything in English.” Where dealing with a foreign term, we are not concerned whether the mark means anything in the English Language but what the term means in the language in which it is written. The foreign equivalent of a merely descriptive English word is no more registrable than its English equivalent would be, regardless of whether or not the foreign term would have any meaning to the general public. See: *Weiss Noodle Co. vs. Golden Cracknel and Specialty Company*, 129 USPQ 441 [CCPA 1961]; *In re The Coney Island Bredzel Company* 199 USPQ 45 [TTAB 1978].”

Thus, our own Supreme Court, in the case of *Etepha vs. Director of Patents (ibid)*, stated:

“And appropriately to be considered now is the fact that, concededly, the ‘tussin’ (in Pertussin and Atussin) was derived from the Latin root word ‘tussis’ meaning cough.

‘Tussin’ is merely descriptive; it is generic; it furnishes to the buyer no indication of the origin of the goods; it is open to appropriation by anyone. It is accordingly barred from registration as trademark. With jurisprudence holding the line, we feel safe in making the statement that any other conclusion would result in ‘appellant having practically a monopoly’ of the word ‘tussin’ in a trademark.”

In the same vein, the Supreme Court stated in the case of *Marvex Commercial Co., Inc. vs. Petra Hawpia* (18 SCRA 1178):

“The trademark ‘Lionpas’ for medicated plaster cannot be registered because it is confusingly similar to ‘Salonpas’, a registered trademark also for medicated plaster. Both the words have the same suffix ‘pas’ which denotes a plaster with curative powers that adheres to the body. However, as ‘pas’ is merely descriptive and furnishes no indication of origin of the article, it is open for appropriation by anyone and may properly become the subject of trademark by combination with another word or phrase.”

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, Application bearing Serial No. 117755 for the mark “COR” filed by COR THERAPEUTICS on 10 February 1997 is hereby REJECTED.

Let the filewrapper of COR subject matter of this case be forwarded to the Administrative, Financial and Human Resources Development Services Bureau for appropriate action in accordance with this Decision with a copy thereof furnished the Bureau of Trademarks for information and update of its records.

SO ORDERED.

Makati City, June 24, 2003.

*ESTRELLITA BELTRAN-ABELARDO*  
*Director, Bureau of Legal Affairs, IPO*